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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,282	12/31/2003	Frederick R. Ernest	25389A	9791
22889	7590	03/24/2006	EXAMINER THISSELL, JENNIFER I	
OWENS CORNING 2790 COLUMBUS ROAD GRANVILLE, OH 43023			ART UNIT 3635	PAPER NUMBER

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/749,282	Applicant(s) ERNEST ET AL.	
	Examiner Jennifer I. Thissell	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/30/04, 5/10/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7 and 14-20, drawn to a corner finishing trim assembly, classified in class 52, subclass 287.1.
- II. Claims 8-13, drawn to a method for making a corner finishing trim assembly, classified in class 52, subclass 741.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made, respectively. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product can be made by a materially different process, such as molding.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

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During a telephone conversation with Maria Gasaway on March 17, 2006 a provisional election was made without traverse to prosecute the invention of a corner finishing trim, claims 1-7 and 14-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

Claims 14-20 are objected to because the language does not consistently claim a subcombination. Regarding claim 14, the language in the claim preamble and body begins as a subcombination, as it recites a first and second trim piece only in the functional language (i.e. the pieces are welded together to form an angled joint “for” slidably receiving a first trim piece...). However, it then claims that the first and second trim pieces are friction fit into the corner finishing trim assembly. Applicant should note that the claims having inconsistent language are

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being considered as having been drawn to the combination. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Ploplis ('057). Ploplis teaches a corner finishing trim having first and second thermoplastic pieces (Figure 11), the first and second polymer pieces are then shown in Figure 1 to be welded together (column 6, line 65) to form an angle. The polymer pieces can be made from polyvinyl chloride (PVC) (column 1, line 12).

It should be noted that claim 7 is considered a product-by-process claim, therefore, determination of patentability is based on the product itself. See MPEP 2113. The patentability of the product does not depend on its method of production. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966

(Fed.Cir.1985). Since Ploplis teaches pieces that are welded together, it is considered to read on the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rasmussen ('861) in view of Ploplis ('057). Rasmussen teaches a corner trim assembly for walls that includes first and second injection molded rigid vinyl (column 10, line 16-18), wherein the first and second pieces are joined together to form an angled joint. There are also first and second trim pieces (202,204 in Figure 5) that are friction fit into the corner trim assembly. Rasmussen does not specifically state that the first and second pieces are extruded polymer pieces, or that the pieces are welded together. However, Ploplis teaches that it is known in the art to provide a trim assembly that is made of thermoplastic polyvinyl chloride (PVC), and that the joint can be welded together. It would have been obvious for one having ordinary skill in the art at the time the invention was made to provide a thermoplastic material for the corner pieces, as the material is resilient and easily manufactured. It would

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have also been obvious to one having ordinary skill in the art at the time the invention was made to weld the pieces together, so that the joint would have additional strength.

It should be noted that claim 20 is considered a product-by-process claim, therefore, determination of patentability is based on the product itself. See MPEP 2113. The patentability of the product does not depend on its method of production. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985). Since Rasmussen in view of Ploplis teaches pieces that are welded together, it is considered to read on the claim.

Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ploplis ('057) in view of Enlow et al. ('US Pat. Publication 2002/0157772). Ploplis teaches an assembly as stated above, but does not include a laminate of foil, UV protective wood grain foil, or white foil. Enlow teaches that it is known in the art to provide a protective and decorative surface film of various laminates on polymeric (PVC and others) materials and panels. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a coating of laminate to a trim panel or assembly in various decorative colors or wood grains, as a matter of design choice. Often the

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trim in homes is white or wood grain, so this would allow for a material that has strength, is resistant to water and sunlight, and eliminates the need for painting or staining.

Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rasmussen ('861) in view of Ploplis ('057), and further in view of Enlow et al. (US Pat. Publication 2002/0157772). Rasmussen with Ploplis teaches an assembly as stated above, but does not include a laminate of foil, UV protective wood grain foil, or white foil. Enlow teaches that it is known in the art to provide a protective and decorative surface film of various laminates on polymeric (PVC and others) materials and panels. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a coating of laminate to a trim panel or assembly in various decorative colors or wood grains, as a matter of design choice. Most often the trim found in peoples homes or offices is white or wood grain, so this would allow for a material that has strength, is resistant to water and sunlight, and eliminates the need for painting or staining.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I.

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Thissell whose telephone number is (571) 272-6849. The examiner can normally be reached on Mondays and Tuesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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